UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,926	01/02/2001	Veronique Mary	ST00001A-US	1240

5487 7590 01/08/2004

ROSS J. OEHLER
AVENTIS PHARMACEUTICALS INC.
ROUTE 202-206
MAIL CODE: D303A
BRIDGEWATER, NJ 08807

EXAMINER	
MAIER, LEIGH C	

ART UNIT	PAPER NUMBER
1623	

DATE MAILED: 01/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

MAILED
JAN 08 2004
GROUP 2900

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 12302003

Application Number: 09/752,926
Filing Date: January 02, 2001
Appellant(s): MARY ET AL.

Irving Newman
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 3, 2003.

(1) Real Party in Interest

The brief does not contain a statement identifying the Real Party in Interest. Therefore, it is presumed that the party named in the caption of the brief is the Real Party in Interest, i.e., the owner at the time the brief was filed. The Board, however, may exercise its discretion to require an explicit statement as to the Real Party in Interest.

(2) Related Appeals and Interferences

The brief states that there are no other related appeals and interferences, known to Appellant, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

There is only one claim on appeal.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct. However, it is noted that the claim contains an obvious typographical error: "patent" should be "patient." This error is in the original.

(9) Prior Art of Record

Pratt, J. et al., "Enoxaparin Reduces Cerebral Edema after Photothrombotic Injury in the Rat" Haemostasis, vol. 28, (1998), pp. 78-85.

(10) Grounds of Rejection

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by PRATT et al (Haemostasis, 1998).

PRATT discloses the administration of a pharmaceutical composition comprising enoxaparin to a subject with cerebral ischemia. The disclosed treatment comprises administration enoxaparin at a dosage protocol of 0.5 mg/kg i.v. followed 15 min. later by 2 mg/kg s.c. starting either 2, 6, or 18 hr after lesion formation. See abstract and page 80, right-hand column. In the specification, "effective amount" is defined as 0.2 mg/kg to 4 mg kg per day s.c. See specification at page 7, second full paragraph.

(11) Response to Argument

Appellant states that the instant invention relates to "the use of enoxaparin to treat – and reduce the size of – ischemic lesions of cerebral ischemia" whereas PRATT is concerned with the treatment of edema that is induced by ischemia, which is in turn induced by photothrombotic lesion. Appellant further contends that PRATT is silent regarding the size of the ischemia itself.

The examiner first notes that the claim is drawn to a "method of treating cerebral ischemia," and the step of the method is "administering to a [patient] in need thereof an effective amount of enoxaparin. The claim recites *treating* but does not require reduction in size.

Silence regarding the size of the ischemia notwithstanding, PRATT does, in fact, disclose administration of an effective amount of enoxaparin to a subject with cerebral ischemia. The reference discloses performing the recited step on the required subject, thereby accomplishing the method.

Appellant goes on to discuss the photothrombotic model used by PRATT and the perceived deficiencies thereof. It appears that Appellant's argument is that this model is not the preferred one for the study of cerebral ischemia and (1) that "it is unlikely that enoxaparin was able to affect lesion volume" in this model; and (2) it would prevent the detection of benefits. That may be, but it is not on point. The claim requires neither reduction in lesion volume nor detection of said reduction.

Finally, Appellant states "Examiner's argument that use of enoxaparin for reducing the size [of] the lesion was inherently practiced in the prior art is untenable and unsupported by any basis in fact." The examiner respectfully submits that it has never been argued that the art discloses reduction in lesion size but maintains that the art does disclose the method, as recited.

Appellant's position is that the cited reference does not describe or suggest the use of enoxaparin in the treatment of cerebral ischemia. This argument contradicts what is clearly stated in the reference, as set forth above. For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

CONFEREES

SAMUEL BARTS
PRIMARY EXAMINER
GROUP 1600

JAMES O. WILSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

JOHANN RICHTER
SUPERVISORY PATENT EXAMINER
GROUP 1600

December 30, 2003